



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,737	05/03/2001	Daniel Schoeffler	SDA-1	8033

20808 7590 06/09/2005

BROWN & MICHAELS, PC
400 M & T BANK BUILDING
118 NORTH TIOGA ST
ITHACA, NY 14850

EXAMINER

NGUYEN, PHUOC H

ART UNIT	PAPER NUMBER
----------	--------------

2143

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/848,737

Applicant(s)

SCHOEFFLER, DANIEL

Examiner

Phuoc H. Nguyen

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) 66 and 67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-67 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

PD

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-65 drawn to resolving an email address of the recipient which is known or believed to be temporarily or permanently invalid, classified in class 709, subclass 206.
 - II. Claims 66-67 drawn to forwarding communications from a sender to a recipient over a network where the recipient has an address which is dynamically assigned, classified in class 709, subclass 245.

The inventions are distinct, each from the other because of the following reasons:

2. Invention of Group II is related to each of the inventions of Group I as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination (Group II) as claimed does not require the particulars of the subcombinations (Group I) as claimed because claims to both the subcombination and combination are presented and assumed to be patentable, the omission of the specific details of the subcombination as recited in claims 1-65 in the combination as recited in claims 66-67 is evidence that the patentability of the combination does not rely on the details of the specific subcombinations. The subcombinations of Group I have separate utility as resolving

Art Unit: 2143

an email address of the recipient which is known or believed to be temporarily or permanently invalid. See MPEP § 806.05(d).

3. Inventions of the Group I are related as subcombinations discloses as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of Group II has separate utility such as forwarding communications from a sender to a recipient over a network where the recipient has an address which is dynamically assigned.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, the search required for one Group is not required for the other Group, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Michael F. Brown, Reg. No. 29,619 on Wednesday, June 1, 2005 and faxed has been received on June 2, 2005 election of Group I (claims 1-65) in the reply is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Affirmation of this election must be made by applicant in replying to this Office action. Claims 66-67 are withdrawn from further consideration by the examiner, 37 CFR 1.142 (b), as being drawn to a non-elected invention.

6. Applicant is reminded the upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

Art Unit: 2143

application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Response to Amendment

7. This office action is in response to the amendment filed on February 16, 2005. Previous office action contained claims 1-67. Amendment filed on February 16, 2005 have been entered and made of record. Due to the restriction requirement and Group I of the restriction was elected by attorney; therefore, pending claims 1-65 are presented for further consideration and examination.

Response to Arguments

8. Applicant's arguments and amendments filed on February 16, 2005 have been carefully considered but they are not deemed fully persuasive.

a. Applicant's arguments is that Tsuei U.S. Patent 6,654,779 does not teach as recited in claim 1.

The examiner respectfully submits that the cited reference discloses in figure 4 a sender composes an email message and send it to sender ISP (e.g. forwarding service). Sender ISP is then routes a message to the recipient ISP. The recipient ISP receive the message and verify whether the address is match or not, if not the message is bounce back to the sender ISP. *The sender ISP is then performing the forwarding service* by sending an address query to EAMS to determine whether the address change (e.g. new address or second address) registered with the EAMS or not, if so it will then send the new or second address to the sender ISP. The sender ISP

Art Unit: 2143

would then notify the sender of new address and sending the email message to the new address (e.g. second address).

b. Applicant's arguments is that Tsuei does not teach the forward communications request a password prior to the forwarding step as recited in claim 1.

The examiner respectfully submits that the cited reference discloses a sender sends a email message to the recipient though the forwarding service (e.g. Sender ISP). Refer to figure 3, before the sender 110 sends an email message to the recipient it must authenticated to the sender ISP (e.g. forwarding service). The authentication process will require to have an unique id and a password. Therefore, the forwarding service has to verify the password before performing the sending service.

9. Claims 2-32, and 34-65 are rejected at least by virtue of their dependency on independent and by other reasons set forth in the previous office action.

10. Accordingly, rejections for claims 1-65 are presented as below.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-6,12-17,20,21,23,24,26,27,29-39,45-50,53,54,56,57,59,60, and 62-65 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsuei U. S. Patent 6,654,779.

Art Unit: 2143

13. Regarding claims 1,33, and 36, Tsuei discloses a method of indirectly forwarding a communication from a sender to a recipient where an old address for the recipient is known or believed to be temporarily or permanently invalid, by sending the communication to a forwarding service at an address different from that of the recipient (Abstract), comprising, at the forwarding service (e.g. figure 3, Sender ISP 120 sends query to EAMS), the steps of receiving the communication (Figure 3, Sender ISP 120 receive communication from the Sender 110); looking up at least the old address in a database (Figure 3, Sender ISP perform look up address by sending a query request to EAMS); retrieving at least one second address from the database, which second address is associated with the old address (Figures 3 and 4, EAMS performs query search by Sender ISP 110 requested and provide the new address based on old email address, 342, and 344 and send it to Send ISP 110); sending the communication to the second address (Figure 4, Sender ISP 110 is then forward message to the new email address 470).

14. Regarding claims 2 and 35, Tsuei discloses in which the old address is sent to the forwarding service as part of the forwarding address (Figure 4).

15. Regarding claims 3 and 37, Tsuei discloses the old address is a part of the communication, and further comprising the step, after step a, of extracting (inherently) the old address from the communication (Figure 4; col. 9, lines 59-64).

16. Regarding claim 4, Tsuei discloses the old address for the recipient is selected from a group comprising: a telephone number, an e-mail address, a postal address, a uniform resource locator, an IP address, an IP address plus at least one time and/or date and/or duration, a file name, a file name plus a location, an instant messaging ID, a pager ID, a personal digital

Art Unit: 2143

assistant ID, a cellphone ID, a cable terminal ID, a direct broadcast terminal ID, a telex number, a teletype number, and an online chat user ID (Figure 3, 340).

17. Regarding claims 5 and 38, Tsuei discloses the second address (e.g. new email address) is selected from a group comprising: a telephone number, an e-mail address, a postal address, a uniform resource locator, an IP address, a file name, a file name plus a location, an messaging ID, a pager ID, a personal digital assistant ID, a cellphone ID, a cable terminal ID, a direct broadcast terminal ID, a telex number, a teletype number, and an online chat user ID (Figure 3, 340).

18. Regarding claims 6 and 39, Tsuei discloses the communication is selected from a group comprising telephone calls; electronic mail messages, postal mail, instant messaging communications, internet protocol communications, web pages, computer file transfer protocols, video transmissions, paging transmissions, personal digital assistant transmissions, cellphone transmissions, cable transmissions, direct broadcast transmissions, telex and teletype communications, and online chat transmissions (Figure 3, internet 130).

19. Regarding claims 12 and 45, Tsuei discloses there is more than one second address associated with the old address, and step d is performed for more than one of the second addresses associated with the old address (col. 7, last paragraph through col. 8, 1st paragraph).

20. Regarding claims 13 and 46, Tsuei discloses if there is a password in the database associated with the new address, prior to forwarding the communication requesting a password from the sender, receiving a password supplied by the sender, comparing the password supplied by the sender to the password in the database, and only performing the sending step d if the comparison is successful (e.g. Figure 3, before the sender 110 sends an email message to the

recipient it must authenticated to the sender ISP (e.g. forwarding service). The authentication process will require to have an unique id and a password. Therefore, the forwarding service has to verify the password before performing the sending service.).

21. Regarding claims 14 and 47, Tsuei discloses sending a communication to the sender with identifying material associated with the more than one second addresses retrieved in step c and requesting the sender to choose from among the more than one second addresses, accepting a choice from the sender selecting at least one of the more than one second addresses, sending the communication to the selected at least one of the more than one second addresses (col. 7, lines 31-52).

22. Regarding claims 15 and 48, Tsuei discloses the at least one second address was registered by the recipient (Figure 5).

23. Regarding claims 16,17,49, and 50, Tsuei discloses the recipient periodically updates the at least one second address, and periodic updating is done automatically (col. 6, lines 30-44).

14. Regarding claims 20 and 53, Tsuei discloses at least one second address was retrieved by the forwarding service from a source other than the recipient (Figure 4).

24. Regarding claims 21 and 54, Tsuei discloses the forwarding step (d) further comprises the step of including additional information in the communication (Figure 3; and col. 6, last paragraph through col. 7, 1st paragraph).

25. Regarding claims 23,24,55 and 57, Tsuei discloses the step of sending a confirming communication back to the sender, and the confirming communication comprises at least the second address to which the communication was forwarded (col. 7, lines 41-46).

26. Regarding claims 26 and 59, Tsuei discloses the old address and at least one second

Art Unit: 2143

address are addresses in the same medium of communications (Abstract).

27. Regarding claims 27 and 60, Tsuei discloses in which the old address and at least one second address are addresses in different media of communications (Figure 3, 340).

28. Regarding claims 29 and 62, Tsuei discloses if the second retrieved in step c is invalid, of using the second address as an old address, and repeating the method from step b (Figure 4, 470 to 420 to 440).

29. Regarding claims 30 and 63, Tsuei discloses the communication is sent to the forwarding service by a server to which the communication was sent by the sender (Figure 4).

30. Regarding claims 31 and 64, Tsuei discloses the server is associated with the sender, and the mail server automatically sends the communication to the forwarding service when the communication is returned as undeliverable (Figure 4, 440).

31. Regarding claim 32 and 65, Tsuei discloses the server is a mail server associated with the old address associated with the recipient, and the mail server automatically sends the communication to the forwarding service when the mail server cannot deliver the communication to the old address (Figures 3 and 4).

Claim Rejections - 35 USC § 103

32. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2143

33. Claims 7-11,18-19,28,40-44,51-52, and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei in view of Fuisz U.S. Patent 6,643,688.

34. Regarding claims 7-11, and 40-44, Tsuei discloses retrieving at least one second address from the database, which second address is associated with the old address; however, Tsuei fails to teach the step of selecting one of the new addresses based on selection criteria such as a password supplied by the sender, a time of day, a priority ranking supplied by the recipient, and the second address returned is a second address having the highest priority, and a next-higher priority second address until a valid second address is found or all second addresses are returned.

Fuisz reference discloses the step of selecting one of the new addresses based on selection criteria such as a password supplied by the sender, a time of day, a priority ranking supplied by the recipient, and the second address returned is a second address having the highest priority, and a next-higher priority second address until a valid second address is found or all second addresses are returned (col. 2, lines 8-12; col. 2, lines 51-61; col. 3, lines 1-31; and col. 4, lines 37-60).

It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to incorporate Fuisz's teaching into Tsuei's method to forward an email message based upon the condition selection technique; as a result, it ensures that email will continue to find its way to the intended recipient.

35. Regarding claims 18-19 and 51-52, Tsuei discloses the at least one second address was registered by the recipient; however, Tsuei fails to teach the recipient specifies at least one sender from whom the recipient does not wish to receive or not receive communications, and the

Art Unit: 2143

sending step d of the method further comprises the step of not sending or sending communications to the at least one sender specified by the recipient.

Fuisz reference discloses the filtering technique which allow user's to create their own filter whether the user's want to receive or not receive message from a certain sender(s) (col. 8, lines 23-36).

It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to incorporate Fuisz's teaching into Tsuei's method to apply the filtering technique Tsuei's invention to allow user with more flexibility to manage their email account.

36. Regarding claims 28 and 61, Tsuei discloses retrieving at least one second address from the database, which second address is associated with the old address; however, Tsuei fails to teach counting the number of communications forwarded for a sender in a selected time period, and not forwarding communications if the sender sends more communications to be forwarded during the selected time period than a selected limit.

Fuisz reference discloses counting the number of communications forwarded for a sender in a selected time period, and not forwarding communications if the sender sends more communications to be forwarded during the selected time period than a selected limit (col. 3, 1st paragraph).

It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to incorporate Fuisz's teaching into Tsuei's method to count the number of forwarded e-mail so it can bills the user.

37. Claims 22,25,55, and 58, rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei.

Tsuei discloses sending the communication to the second address further comprises the step of including additional information in the communication, and send the confirmation to the sender; however, Tsuei fails to teach additional information is advertising, the confirming communication also comprises additional information at least in the form of advertising.

It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to provide additional information such as advertising attach to the message to attract sender attention to a product or business.

Conclusion

38. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuoc H. Nguyen whose telephone number is 571-272-3919. The examiner can normally be reached on Monday - Friday.

Art Unit: 2143

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Phuoc H Nguyen
Examiner
Art Unit 2143

June 3, 2005

A handwritten signature in black ink, appearing to read 'B. Jaroenchonwanit', with a stylized flourish at the end.

**BUNJOB JAROENCHONWANIT
PRIMARY EXAMINER**